

REMARKS

Claims 7-17 are pending in connection with the above-identified application. Support for new claims 7-17 is found in original claims 2, 3, 5 and 6, as well as at page 12, lines 21-23 of the specification.

Issues under 35 USC 112

Original Claims 1, 2, and 4 were rejected under 35 USC 112, first paragraph, as allegedly failing to comply with the enablement of requirement. This rejection is traversed based on the following reasons.

The Office Action states that the test examples in the present application based on a single mixture cannot support the originally claimed genus of mixtures. It is first noted that the present claims have been modified to be limited to reciting a sub-genus of component (a) compounds (e.g. claims 7 and 12) or specific components (e.g. claims 9-11 and 13-15) or specific component ratios (e.g. claims 8, 16 and 17). Since the present claims recite components having closely related structures which are described to exhibit closely related properties, one skilled in the art would conclude that the various mixtures encompassed by the present claims would exhibit yield increasing properties in glyphosate-resistant legumes corresponding to the properties exhibited by the mixtures tested in the experiments described at pages 14-15 of the present specification. The present specification provides considerable direction and guidance about how to practice the present invention with respect to preferred active ingredients, formulation details and conditions for application of the mixtures. In this regard, it is submitted that the specification need not contain an example if the invention is otherwise disclosed in such manner that one skilled in the art will be able to practice it without an undue amount of experimentation. *In re Borkowski*, 422 F.2d 904, 908, 164 USPQ 642, 645 (CCPA 1970). It is respectfully submitted that the present situation corresponds to *In re Wands*, 858 F.2d 731, 8 USPQ2d 1400 (Fed. Cir. 1988), in which the court reversed the rejection for lack of enablement under 35 USC 112, first paragraph, concluding that undue experimentation would not be required to practice the invention. Another applicable case is *In re Bundy*, 642 F.2d 430, 434,

209 USPQ 48, 51-52 (CCPA 1981), in which the court ruled that appellant's disclosure was sufficient to enable one skilled in the art to use the claimed analogs of naturally occurring prostaglandins even though the specification lacked any examples of specific dosages, because the specification taught that the novel prostaglandins had certain pharmacological properties and possessed activity similar to known E-type prostaglandins. Consequently, it is submitted that the present claims satisfy the enablement requirement such that the above-noted rejection should be withdrawn.

Issues under 35 USC 102(a)

Original Claims 1-6 were rejected under 35 USC 102(a) as being unpatentable over Asrar '371 (US 2003/0060371).

Original Claims 1, 2, 4 and 5 were rejected under 35 USC 102(a) as being unpatentable over Ramsdale et al. (Ramsdale et al., Res. Rep. North Cent. Weed. Sci. Soc., Vol. 59, 2002, pages 280-283).

The above-noted rejections are traversed based on the following reasons.

Asrar '371 fails to disclose any specific examples of the mixture of components (a) and (b) as recited in the present claims, or the application of such a mixture on to glyphosate-resistant legumes as in other claimed embodiments of the present invention. Consequently, Asrar '371 clearly fails to anticipate any of the present claims such that the above-noted anticipation rejection based on this reference must be withdrawn.

The above-noted rejection based on Ramsdale et al. should be withdrawn as Applicant is submitting with this Amendment a verified English translation of the priority application which removes Ramsdale et al. as an effective prior art reference based on the following facts. Ramsdale et al. is an abstract of an oral lecture, a so-called "Research Report", held on the 57th annual conference of the North Central Weed Science Society. This conference took place from December 2 to December 5, 2002 in St. Louis. In order to prove this, enclosed are pages 1 and 2

of NCWSS News, vol. 19, no. 3. The abstract itself was published on CD-ROM, which was made available to the public in January of 2003. In order to establish this fact, enclosed is page 1 of the instructions (Exhibit A) for the preparation of brief research reports for the 2002 NCWSS Research Report. From these instructions, it can be seen that the research report was available only in January of 2003 (see the second paragraph). Since the present application claims priority based on the priority application DE 10252881.0 filed November 12, 2002 for which a verified English translation is being submitted, and since the present claims are supported by the disclosure of this priority application, the Ramsdale et al. reference is no longer effective prior art under 35 USC 102(a) against any of the claims of the present application such that the above-noted rejection should be withdrawn.

Issues under 35 USC 103(a)

Claims 1-6 have been rejected under 35 USC 103(a) as being obvious over Asrar '371. This rejection is traversed based on the following reasons.

Asrar '371 discloses a method for improving the yield and vigor of an agronomic plant, such as soybeans, by treating the plants and/or their propagation material with a composition that comprises an active agent, such as a diazole fungicide, a triazole fungicide or a strobilurin-type fungicide (see abstract and paragraph [0013]). The method can be carried out by seed treatment or, after the plants have sprouted, by foliar applications. In the latter case, the active agent can also be combined, if desired, with other agents, such as herbicides. If the supplementary active agent is an herbicide, it is preferred that the plant be a transgenic plant having a transgenic event that provides resistance to the particular herbicide used. The aim of this combination is said to be "to obtain further beneficial results" (see paragraph [0028]). The Asrar '371 document is silent about what is meant by these "further" beneficial results. Thus, a skilled person must deduce that this combination is only intended to combine two different, independent positive features, namely the improvement of the vigor/yield by the fungicide plus a protection of the plant against unwanted weeds by the herbicide. There is not the slightest hint regarding the combined action of a fungicide and a herbicide to increase crop yield.

In contrast, the claimed subject matter of the present invention is directed to a method for increasing the yield in glyphosate-resistant legumes, which includes treating the plants with a synergistic mixture comprising a strobilurin Ia and a glyphosate derivative II. In other words, the glyphosate derivative II is used as a synergist for the strobilurin fungicide Ia and thus serves a completely different purpose than in the Asrar '371 reference. Asrar '371 fails to recognize the synergistically and advantageously improved crop yield achieved by the present invention as evidenced by the comparative test results described at pages 14-15 of the present specification. Consequently, significant patentable distinctions exist over Asrar '371. Even if prima facie obviousness is assumed to have been properly alleged, such obviousness has been rebutted by the evidence of unexpected, advantageous properties shown by the comparative test results. Thus, it is requested that the above rejection be withdrawn.

It is submitted for the reasons above that the present claims define patentable subject matter such that this application should now be placed in condition for allowance.

If any questions arise in the above matters, please contact Applicant's representative, Andrew D. Meikle (Reg. No. 32,868), in the Washington Metropolitan Area at the phone number listed below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated: May 2, 2008

Respectfully submitted,

By 

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Enclosures: Exhibit A
Letter Submitting English Translation of Priority Application